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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,553	01/23/2004	Jochen Von Der Hardt	010743.52910US	3212
23911	7590	10/14/2005	EXAMINER	
CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			PERRIN, JOSEPH L	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,553

Applicant(s)

VON DER HARDT ET AL.

Examiner

Joseph L. Perrin, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06 September 2005 has been entered.

### ***Response to Arguments***

2. Applicant's amendment to claim 1 renders moot the rejection under 35 USC §112, second paragraph.

3. Applicant's arguments filed 06 September 2005 have been fully considered but they are not persuasive. In response to applicant's arguments that the compressed air source of KONONOV does not read on applicant's claimed "internal reference tank", this is not persuasive because the compressed air source of KONONOV is construed as part of the device of KONONOV and, therefore, reads on the relative terminology "internal". Even if, *arguendo*, one were to construe the compressed air source as being an external tank, the position is taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange a compressed air source external to a device to an internal location, since it has been held that

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rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. The structural limitations of KONONOV read on applicant's claimed apparatus.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: In line 19, the phrase "said referenced tank" should be --said reference tank--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 11, it is unclear how a compressed air tank is capable of detecting a pressure drop. Clarification and correction are required.

### ***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 11-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KONONOV (previously cited). Re

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claims 11-19, KONONOV discloses a device 8 having a CPU 13 controlling a plurality of pneumatic valves V1-V13 (having "an open state" and "a closed state") connecting a plurality of lines having "internal volumes" and external connections (various lines) connected to filter housing 10, a cleaning supply (top left of Figure 1), a compressed air source (top left of Figure 1) which reads on an internal or external tank, and an external tank (tank 66 or cleaning liquid supply) (see Figure 1 and relative associated text, *i.e.* col. 2, line 65 *et seq.*). KONONOV does disclose a compressed air source connected by connecting lines as part of the device (Figure 1 and relative associated text) (construed to read on an "internal" or "external" reference tank since the compressed air source is part of the device and terminology such as "internal" and "external" are relative terms which are construed broadly). Even if, *arguendo*, one were to construe the compressed air source as being an external tank, the position is taken that it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange a compressed air source external to a device to an internal location, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. If applicant takes the position that the claimed invention requires plural compressed air tanks, the position would be taken that duplicating parts (*i.e.* compressed air tanks) would be obvious since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8; *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over KONONOV in view of PHIPPS, Jr. (previously cited). Recitation of Kononov is repeated here from above. Although KONONOV discloses the need for sterilization of the apparatus for food and drug manufacturing standards (col. 2, lines 3-24), Kononov does not expressly disclose using steel or PTFE lines or parts. PHIPPS, Jr. teaches that it is known to utilize steel or PTFE (Teflon®) plumbing parts due to their inertness, *i.e.* bioresistivity (col. 6, lines 48-55). Therefore, the position is taken that a person of ordinary skill in the art at the time the invention was made would have been motivated to utilize bioresistant materials in the apparatus of KONONOV in order to maintain sterilization integrity of the filter test system.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, PhD whose telephone number is (571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael E. Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jlp

A handwritten signature in black ink, appearing to read 'Joe Perrin', is positioned above the printed name.

**JOSEPH L. PERRIN, PH.D.**  
**PRIMARY EXAMINER**